

REMARKS**I. General**

Claims 98-100, 106-112, 117, 120-123, and 125 are pending in the current application and are rejected. The issue asserted in the Office Action mailed January 27, 2004 is:

- Claims 98-100, 106-112, 117, 120-123, and 125 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 6,331,972 to Harris et al. (hereinafter *Harris*).

II. Claim Amendments

Claim 106 is amended to recite aspects related to the customers accepting the transaction amounts using wireless devices as clearly stated in the preamble of claim 106 and in the specification at page 4, lines 15-25. No new matter is added by the claim amendment.

III. Failure to Clearly Communicate Findings for Rejection

Applicant notes that although the Examiner has indicated that claims 98-100, 106-112, 117, 120-123, and 125 are rejected in the Office Action, the claims are not clearly and specifically addressed. The Examiner fails to address each element of claims 98-100, 106-112, 117, 120-123, and 125. In rejecting the pending claims, the Examiner merely makes reference to Figures 30-32 and element 452 of Figure 30. However, the mere listing of a Figure number fails to clearly address each element of the pending claims. Moreover, the Examiner makes no reference to any specific column or line number in *Harris* in rejecting the pending claims. Specifically, in rejecting the claims, the Examiner merely states that *Harris* discloses a system for processing financial data for transmission in which customers use wireless devices with a merchant for correlating the financial data with customer information to select individual profiles to facilitate the transaction of funds within a geographic area for a point-of-sale device. (Office Action, page 2). However, the mere paraphrasing of the claims along with a general assertion that the applied art teaches the pending claims is not consistent with office policy. For example, the Examiner fails to address at least the features of the independent claims shown below:

Claim 98 The Examiner fails to address which portion of *Harris* discloses a system for processing financial data in which customers use wireless devices to identify point of sale locations and a means for receiving said financial data from said point of sale locations.

Claim 106 The Examiner fails to address which portion of *Harris* discloses charging said transaction amounts to accounts selected by said customers and crediting said transaction amounts to accounts selected by merchants at said point of sale locations.

Claim 107 The Examiner fails to address which portion of *Harris* discloses identifying a geographic area for a customer who has initiated a transaction using a wireless device, said identifying step accomplished by determining a specific wireless cell that is in communication with said customer's wireless device.

Claim 117 The Examiner fails to which portion of *Harris* discloses a means for displaying point-of-sale locations to a user via one or more menus on the wireless device, the menus listing at least one point-of-sale location based upon a current location of the wireless device, wherein the current location of the wireless device is determined by identifying a current cell of said wireless network that is in communication with the wireless device, and the menu display configured according to a user profile.

Claim 123 The Examiner fails to address which portion of *Harris* discloses identifying a current location of the user by determining a current wireless network cell that is in communication with the user's wireless device or transmitting a list of transaction locations to be displayed to the user via the wireless device, wherein said list of transaction locations is selected from a user profile and is selected in part based upon the user's current location.

Claim 125 The Examiner fails to address which portion of *Harris* discloses selecting a desired type of product or service from a first list displayed on the wireless device; selecting, from a second list displayed on the wireless device, a location where the selected type of product or service is offered; and selecting a particular point-of-sale terminal at the selected location.

Accordingly, Applicant respectfully points out that whenever, on examination, any claim for a patent is rejected, the Examiner must provide notification of the reasons for rejection together with such information and references as may be useful in judging the propriety of continuing the prosecution. 35 U.S.C. § 132. The Examiner is also required to *clearly communicate* findings, conclusions, and reasons which support all proposed rejections. M.P.E.P. § 2106 (VII). The Examiner has not specifically articulated the rejections of claims 98-100, 106-112, 117, 120-123, and 125 and has failed to clearly communicate findings for rejections early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise respond completely at the

earliest opportunity. M.P.E.P. §706. Thus, in accordance with the requirements under M.P.E.P. §§706 and 2106 (VII), Applicant respectfully requests that if the Examiner maintains the current rejections, that he identify the specific portions of the applied art which meet each claim element so that that Applicant may have a full and fair opportunity to explore the patentability of these claims.

IV. Rejection under 35 U.S.C. § 103(a)—*Harris*

Claims 98-100, 106-112, 117, 120-123, and 125 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Harris*. Applicant respectfully traverses this rejection and asserts that the rejected claims are allowable at least for the reasons stated below.

To establish a prima facie case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. §2143. Without conceding any other criteria, Applicant respectfully asserts that the rejection does not satisfy at least the first and third criteria, and therefore, the claims are patentable under 35 U.S.C. § 103(a).

A. Failure to teach or suggest all claim limitations

1. Independent Claims

Claim 98

Claim 98 requires, in part:

A system for processing financial data for transactions in which customers use wireless devices to identify point of sale locations and to confirm transaction amounts, said system comprising:

means for receiving said financial data from said point of sale locations;

The disclosure of *Harris* fails to disclose these features of claim 98. The Examiner fails to specifically state which portion of *Harris* is relied upon in rejecting this feature of claim 98. Therefore, based on the Examiner's assertion, Applicant assumes the Examiner relied on the portions of *Harris* discussed below. *Harris* discloses a sequence of data exchange messages that take place during a financial transaction between a personal transaction and storage device (407) and the various objects (454, 456, 458, 460) involved with a particular financial transaction. (*Harris*, col. 23, lns. 1-12). The financial transaction occurs with a buyer scanning a bar-code on a product and initiating a purchase transaction. After the merchant parses the product information and buyer's banking information, a banking request is initiated to the merchant's bank. (*Harris*, col. 23, lns. 49-55). The merchant's bank then initiates a financial transaction with the buyer's bank, such as a transfer to cover the cost of the requested purchase, and after the merchant's bank receives an acknowledgment from the buyer's bank, the merchant's bank will send acknowledgements to the merchant. (*Harris*, col. 23, lns. 55-59). The merchant will then send tailored information back to the buyer, such as product code, receipt, and generalized product tags associated with the purchase. (*Harris*, col. 23, lns. 59-65). However, *Harris* fails to teach or suggest a means for receiving financial data from point of sale locations that were identified by customers through wireless devices. Thus, *Harris* fails to teach all elements of claim 98. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 98 be withdrawn.

Claim 106

As amended, claim 106 requires, in part:

charging said transaction amounts to accounts selected by said customers wherein said customers accept said transaction amounts using said wireless devices;

The disclosure of *Harris* fails to disclose this feature of amended claim 106. As stated above, *Harris* discloses a sequence of data exchange messages that take place during a financial transaction between a personal transaction and storage device (407) and the various objects (454, 456, 458, 460) involved with a particular financial transaction. (*Harris*, col. 23, lns. 1-12). In addition, *Harris* discloses that the merchant parses out the price and product information and initiates a banking request to the merchant's bank to eventually initiate the

appropriate financial transaction with the buyer's bank, such as a transfer request to cover the cost of the requested purchase. (*Harris*, col. 23, lns. 49-55). However, *Harris* fails to teach or suggest that the user accepts the transaction amount using the wireless device. Thus, *Harris* fails to disclose all the elements of amended claim 106.

Claim 106 further requires:

charging said transaction amounts to accounts selected by said customers.

The disclosure of *Harris* also fails to disclose this feature of claim 106. The Examiner fails to address this feature in rejecting claim 106. Therefore, based on the Examiner's rejection, Applicant assumes the Examiner relied on the features of *Harris* discussed below in rejecting claim 106. *Harris* discloses a series of messages exchanged between various parties during a financial transaction. (*Harris*, col. 23, lns. 1-12). In addition, *Harris* discloses that the merchant (456) will initiate a banking request to the merchant's bank (458) wherein the merchant's bank (458) will then initiate appropriate financial transactions with the buyer's bank (460). (*Harris*, col. 23, lns. 49-55). However, the mere disclosure of a merchant's bank initiating a financial transaction with the buyer's bank does not disclose charging transaction amounts to accounts selected by the customer. Thus, *Harris* fails to teach all elements of amended claim 106. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 106 be withdrawn.

Claim 107

Claim 107 requires, in part:

identifying a geographic area for a customer who has initiated a transaction using a wireless device, said identifying step accomplished by determining a specific wireless cell that is in communication with said customer's wireless device;

if more than one of said point of sale locations are within said geographic area, then prompting said customer to select a point of sale location from a list of said point of sale locations within said geographic area, and communicating financial data for a selected point of sale location to said customer's wireless device over said wireless network.

The disclosure of *Harris* fails to disclose these features of claim 107. The Examiner fails to specifically state which portion of *Harris* is relied upon in rejecting these features of claim 107. Therefore, based on the Examiner's assertions, Applicant assumes the Examiner relied on the portions of *Harris* discussed below in rejecting claim 107. *Harris* discloses various relationships between peers in a capability addressable, wireless, peer-to-peer data communication network that supports an unlimited number of connections between peers. (*Harris*, col. 6, lns. 10-20). In addition, *Harris* discloses a sequence of data exchange messages that take place during a financial transaction between a personal transaction and storage device (407), and the various objects (454, 456, 458, 460) that are involved with a particular financial transaction. (*Harris*, col. 23, lns. 1-12). However, the disclosure of a wireless peer-to-peer communication network and a sequence of data exchanges that occur during a financial transaction fails to teach or suggest the identifying of a geographic area for a customer who has initiated a transaction using a wireless device that is accomplished by determining a specific wireless cell that is in communication with the customer's wireless device and also fails to teach or suggest that if more than one point of sale location is within the geographic area, then prompting the customer to select a point of sale location from a list of the point of sale locations within the geographic area, and communicating financial data for a selected point of sale location to the customer's wireless device over the wireless network. Thus, *Harris* fails to teach all the elements of claim 107. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 107 be withdrawn.

Claim 117

Claim 117 requires, in part:

means for displaying point-of-sale locations to a user via one or more menus on the wireless device, the menus listing at least one point-of-sale location based upon a current location of the wireless device, wherein the current location of the wireless device is determined by identifying a current cell of said wireless network that is in communication with the wireless device, and the menu display configured according to a user profile.

The disclosure of *Harris* fails to disclose this feature of claim 117. The Examiner fails to specifically state which portion of *Harris* is relied upon in rejecting this feature of

claim 117. Therefore, based on the Examiner's assertions, Applicant assumes the Examiner relied on the portions of *Harris* discussed below in rejecting claim 117. *Harris* discloses various relationships between various peers in a capability addressable, wireless, peer-to-peer data communication network that supports an unlimited number of connections between peers. (*Harris*, col. 6, lns. 10-20). In addition, *Harris* discloses a sequence of data exchange messages that take place during a financial transaction between a personal transaction and storage device (407), and the various objects (454, 456, 458, 460) that are involved with a particular financial transaction. (*Harris*, col. 23, lns. 1-12). However, there is no teaching or suggestion of determining the current location of the wireless device by identifying a current cell of the wireless network that is in communication with the wireless device wherein the menu display is configured according to a user profile. Thus, *Harris* fails to teach all the elements of claim 117. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 117 be withdrawn.

Claim 123

Claim 123 requires, in part:

- identifying a current location of the user by determining a current wireless network cell that is in communication with the user's wireless device;
- transmitting a list of transaction locations to be displayed to the user via the wireless device, wherein said list of transaction locations is selected from a user profile and is selected in part based upon the user's current location;
- transmitting a list of point-of-sale terminals to be displayed to the user via the wireless device, wherein the point-of-sale terminals are located at the selected transaction location;
- prompting the user to accept or reject the displayed transaction amount;

The disclosure of *Harris* fails to disclose these features of claim 123. The Examiner fails to specifically state which portions of *Harris* are relied upon in rejecting these features of claim 123. Therefore, based on the Examiner's assertions, Applicant assumes the Examiner relied on the portions of *Harris* discussed below in rejecting claim 123. *Harris* discloses various data exchange messages that occur between parties (452-460) during a financial transaction between a personal transaction storage device (407) and the objects

involved with the financial transaction. (*Harris*, col. 23, lns. 1-12). The messages begin with a buyer scanning a bar-code on a product wherein the financial transaction is initiated by the buyer after scanning the product. The merchant will parse out price and product information and initiate a bank request to the merchant's bank. (*Harris*, col. 23, lns. 49-53). The merchant's bank will then initiate an appropriate financial transaction with the buyer's bank who will acknowledge the financial transaction so the information can be processed for the merchant's account. (*Harris*, col. 23, lns 52-58). The merchant's bank will then send an acknowledgement to the merchant who in turn will send information to the buyer. However, there is no mention or teaching of: identifying a current location of the user by determining a current wireless network cell that is in communication with the user's wireless device; transmitting a list of transaction locations to be displayed to the user via the wireless device, wherein the list of transaction locations is selected from a user profile and is selected in part based upon the user's current location; transmitting a list of point-of-sale terminals to be displayed to the user via the wireless device, wherein the point-of-sale terminals are located at the selected transaction location; and prompting the user to accept or reject the displayed transaction amount. Thus, *Harris* fails to teach all the elements of claim 123. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 123 be withdrawn.

Claim 125

Claim 125 requires, in part:

- selecting a desired type of product or service from a first list displayed on the wireless device;
- selecting, from a second list displayed on the wireless device, a location where the selected type of product or service is offered;
- selecting a particular point-of-sale terminal at the selected location;
- receiving a transaction amount that is associated with the point-of-sale terminal, wherein the transaction amount is displayed on the wireless device;

The disclosure of *Harris* fails to disclose these features of claim 125. The Examiner fails to specifically state which portions of *Harris* are relied upon in rejecting these features of claim 125. Therefore, based on the Examiner's assertions, Applicant assumes the

Examiner relied on the portions of *Harris* discussed below in rejecting claim 125. As discussed above, *Harris* discloses the various data exchange messages that are transferred between various parties, such as a buyer, a merchant, the merchant's bank, and the buyer's bank, in completing a financial transaction. *Harris* specifically discloses the steps that occur during a financial transaction in a three-way electronic purchase. (*Harris*, col. 23, lns. 1-36). The steps involve the data messages that are transferred between the merchant and the merchant's bank, the merchant's bank and the buyer's bank, and the merchant and the buyer. *Harris* also discloses that the buyer may directly transfer information to the merchant with complete control of information transfer resident with the buyer. (*Harris*, col. 23, ln. 66 to col. 24, ln 3.). However, the disclosure of *Harris* fails to disclose a method for processing a financial transaction using a wireless device that comprises: selecting a desired type of product or service from a first list displayed on the wireless device; selecting, from a second list displayed on the wireless device, a location where the selected type of product or service is offered; selecting a particular point-of-sale terminal at the selected location; and receiving a transaction amount that is associated with the point-of-sale terminal, wherein the transaction amount is displayed on the wireless device. Thus, *Harris* fails to teach all the elements of claim 125. Therefore, Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 125 be withdrawn.

2. Dependent Claims

Claims 99, 100, 108-112, and 120-122 depend directly or indirectly from their respective base claims 98, 107, and 117 and thereby inherit all of the respective limitations. Accordingly, it is respectfully submitted that the dependent claims are allowable based on at least their dependency from independent base claims 98, 107, and 117 for at least the reasons discussed above. Thus, Applicant respectfully submits that based on the arguments above, claims 99, 100, 108-112, and 120-122 are patentable under 35 U.S.C. § 103.

B. Lack of Motivation

It is well settled that the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the level of skill in the art. M.P.E.P. §2143, citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Examiner concedes that *Harris* fails to disclose displaying a list of point-of-sale device locations. However, the

Examiner attempts to cure the deficiencies of *Harris* by asserting that to display a list of point-of-sale device locations would have been obvious to one of ordinary skill in the art. (Office Action at 2). The mere assertion that it would have been obvious to one of skill in the art does not establish the presence of a suggestion within the prior art to make the claimed combination. Furthermore, the Examiner's assertion that displaying a list of point of sale device locations (1) is known from advertising, (2) is the type of information contained in a wallet, and (3) is known from the varied use of advertising slogans and the varied use of making a pitch for a product using varied terms fails to establish motivation for providing a list of point of sale device locations. Thus, the Examiner fails to provide proper motivation for adding the displaying of a list of point of sale locations.

Impermissible Hindsight

Furthermore, Applicant respectfully asserts that the Examiner is relying on impermissible hindsight in order to piece together the elements of the claims based on knowledge gleaned from Applicant's disclosure. *Harris* discloses a financial transaction where a buyer uses a barcode reader to scan product barcodes to begin a financial transaction. (*Harris*, col. 23, lns. 30-40). After scanning the product, the buyer provides banking information to the merchant. The merchant then initiates a banking request to the merchant's bank so that the merchant's bank can initiate an appropriate financial transaction with the buyer's bank, such as a simple transfer request to cover the cost of the requested purchase. (*Harris*, col. 23, lns 50-60). However, *Harris* makes no mention of providing information pertaining to point of sale device locations, such as a list of point-of-sale device locations or which point of sale device locations are within a geographic area. Thus, Applicant asserts that without the teachings of Applicant's disclosure one of ordinary skill in the art would not find it obvious to provide data pertaining to point of sale device locations from the disclosure of *Harris*. However, as stated above, the teaching or suggestion to make the claimed combination must be found in the prior art, not in Applicant's disclosure. See M.P.E.P. §2143, citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Thus, the motivation to combine provided by the Examiner is improper, as the motivation must be described in a prior art reference and must detail the benefits of such a modification. M.P.E.P. § 2145 (X). Therefore, Applicant respectfully requests that the Examiner provide proper motivation for such combination or that the rejection under 35 U.S.C. § 103 be withdrawn.

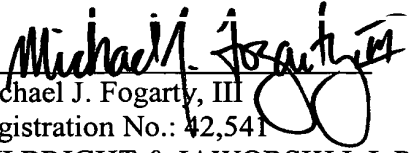
V. Summary

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2380, under Order No. 51410/P003US/09705003 from which the undersigned is authorized to draw.

Dated: April 27, 2004

Respectfully submitted,

By 
Michael J. Fogarty, III
Registration No.: 42,541
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue, Suite 2800
Dallas, Texas 75201-2784
(214) 855-8000
(214) 855-8200 (Fax)
Attorney for Applicant